

REQUEST FOR CORRECTION OF TYPOGRAPHICAL ERROR

The inventor has requested that the name as printed on the application, and any resulting patent, be changed as to the order of first name and last name.

The inventor is Chinese and by custom, stated his last name first and first name last on the original filing which is the normal procedure of his home country.

The inventor's name should be listed as WEI CHEN rather than the reverse order in which it was originally stated by the inventor.

ARGUMENTS IS RESPONSE TO OFFICE ACTION

Drawings

A proposed change to drawing number 1 is attached better showing the thumb grip 50 and the jaw member 18 numerals.

The Applicant proposes to submit new formal drawings from of drafting quality with typed numbers subject to the approval of the Examiner of this change. The pre submitted correction to drawing figure 2, and a clean formal copy of figure 3 would also be submitted to present a cleaner patent.

CLAIMS OBJECTIONS PER SECTION 112

Applicant has made the suggested corrections to the claims to better define the patentable subject matter and overcome the Examiner's noted 112 concerns.

Claim Rejections per Mead in view of Haberle per 35 USC §103

The Examiner has cited the combination of Mead (US 2,028,406) in view of Haberle (US 2,742,808) against claims 1,2,5-7 16 and 17.

The Examiner has indicated that as best understood the cited combination would be an obvious combination to yield Applicant's claimed invention.

The cited references appear to have been found after a thorough search of the prior art for the individual features of Applicants' invention. Such a rejection based on using

applicant's claimed invention as a teaching guide is not as the Court of Appeals for the Federal Circuit noted in Connell et al. v. Sears, Roebuck & Co. (CA FC, 1983), 20 USPQ 193 at 199, is not proper:

"The opinion says obviousness is established when 'features that distinguish' the invention from the closest reference 'are disclosed in analogous structures in which the features perform the identical function'. It is not 'features' but the subject matter as a whole which must be considered, 35 U.S.C. 103. That features, even distinguishing features, are 'disclosed in the prior art' is alone insufficient. As above indicated, it is common to find elements or features somewhere in the prior art. Moreover, most if not all elements perform their ordained and expected function. The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made."

Further, the cited art fails to teach applicant's element of the working end of said handle having a continuously curved handle face substantially in a smooth arc formed substantially along a circumference of a first circular path around a first center point adjacent to said fixed point on the handle. Haberle has an oblong shape to the handle face structure and Mead too lacks the form of an arc in a first circular path.

As noted on page 4 lines 20 to 29 and page 9 lines 5-12 of the original application, the provision of these two substantially circular paths of the gripping surfaces provides a substantially parallel contact by both surfaces of a gripped object which has been found to equalize pressure on the gripped object.

This substantially parallel grip is provided from the first point with the planar face substantially normal to the handle axis and closest to the curved handle face, to the maximum distance of the planar surface is farthest away from the handle face. This is described in the specification as noted and shown best in figures 1 and 3.

Neither cited patent provide this dual circular path of both gripping surfaces and substantially parallel grip at all points the.

As also noted in the claims, Applicant's device provides a substantially flat surface area forming thumb grip on a second jaw member strut adjacent an elbow at the distal end of the first jaw member. Mead provides no such angled engagement of two jaw members or any mention of a thumb grip or need for one. Haberle, also lacks this unique configuration of angled engagement and instead provides a projection for a thumb grip which would be virtually impossible to depress with a thumb while gripping the wrench because the user has to get past the extending member forming the thumb grip.

Finally, both cited references lack applicants claimed formation using an angled engagement of two struts at an elbow. As noted in the specification, this angled engagement provides a means to vary the maximum distance of the two working faces from each other by increasing the distance to the elbow or changing the angle of engagement at the elbow. (Page 9 line 20 to page 10 line 15)

This unique engagement of two elongated strut portions at an elbow thereby provides the unobstructed thumb grip adjacent to the elbow and determines the arc of the second circular path around the first. Neither cited reference teaches or suggest this construction to provide these benefits.

"Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 932, 933 (Fed. Cir. 1984)

Since the prior art lacks any teaching of the aforementioned elements only taught by Applicant, singularly or in combination, or the utility they provide, the objection under section 103 is respectfully traversed.

Final Remarks

It has been shown, that Applicant's device claims elements providing function which are neither taught or suggested in the cited prior art one of which teaches away from Applicant's device. Applicant as noted in the specification considers the improvement to be substantial and provide great benefits to the user.

However, even if the Examiner does not consider Applicant's claimed device a great advance, it has been established that one should not be deprived of patent protection where it can be shown that a genuine improvement has been made, on comparison with other intentions in the art, even if the improvement lacks the appearance of a great advance in the art.

In re Lange, 128 USPQ 365, the CCPA on page 367 states that: "We think that the present application is a distinct improvement of Jezalik and represents an advance in the art not obvious, having patentable novelty. The art is a crowded and comparatively simple one and in such an art, great advances are not to be expected. However patentability will not be denied to an invention which accomplishes a small, but nevertheless genuine improvement not thought of by others.."

Here the art is crowded as noted by the Examiner, but even if Applicant's improvement were to be considered a small one, case law indicates that it should be considered patentable.

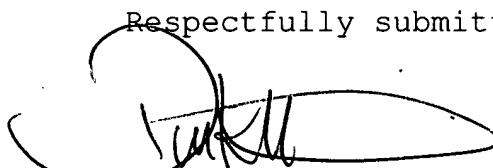
Further, the CCPA in the recent case of re Meng and Driessen, 181 USPQ 94, on page 97, reiterated the principal that even though the invention seems a simple advance over prior art, *after the fact*, simplicity, particularly in a crowded art, argues *for*, rather than against patentability.

As such, even in a crowded art, where the examination and review process has the benefit of a hindsight analysis, the improvements of applicant's device argues *for* patentability.

Considering that Applicant's device has elements not taught or suggested in the prior art, and considering that major, and minor improvements, in a crowded art argue for patentability, claims 1,2,5-7, 9, 16, and 17, should now be allowable.

Should the Examiner have any further questions or concerns the Examiner wishes to address by Examiner's amendment by telephone or otherwise, or, should the Examiner have suggestions to more clearly define the subject matter of the claims to more clearly define the patentable subject matter, the Applicant's attorney would be most receptive to such by telephone or Examiner's amendment.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Donn K. Harms', is written over a horizontal line.

Donn K. Harms
Reg No 38,911
Attorney for Applicant
04/13/05

12702 Via Cortina, Ste. 100
Del Mar, CA 9014
Tel: (858) 509-1400
Fax: (858) 509-1677